

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/880,269

Filing Date: June 13, 2001

Title: Uncrosslinked Foams Made from Emulsions

Page 5

Dkt: 56139USA5A.002

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 10, 2006.

Claim 1 is currently amended, claim 2 has previously canceled, and claims 14-22 have been withdrawn; as a result, claims 1, 3-13 and 23 are now pending in this application.

Affirmation of Election

As provisionally elected by Applicants representative, Mr. Edman, on January 6, 2006, Applicant elects to prosecute the invention of Group I, claims 1, 3-13 and 23, drawn to a process of making uncrosslinked polymeric foams.

The claims of the non-elected invention, claims 14-22, are withdrawn. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

'112 Rejection of the Claims

Claims 1, 3-13 and 23 were rejected under 35 USC Section 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully disagree. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404.

To comply with 35 U.S.C. 112, first paragraph, it is not necessary to "enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68

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Page 6

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USPQ2d 1940, 1944 (Fed. Cir. 2003) (an invention directed to a general system to improve the cleaning process for semiconductor wafers was enabled by a disclosure showing improvements in the overall system). Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention.

The pending claims are directed to a process for making an uncrosslinked polymeric foam comprising mixing a reactive phase comprising at least one polymerizable material comprising a monomer containing a reactive functional group, the polymerizable material having an effective glass transition temperature sufficient to permit the formation of a stable foam upon polymerization of the material and subsequent removal of an immiscible phase. The reactive phase contains no effective amount of crosslinking agent and at least one emulsifier with at least one photoinitiator system and a liquid immiscible with the reactive phase to form an emulsion, wherein the immiscible liquid forms a discontinuous or co-continuous phase with the continuous reactive phase.

Applicants have clarified the invention to include at least one polymerizable material comprising a monomer containing a reactive functional group. This, in combination with the requirement that the reactive phase contains no effective amount of crosslinking agent and at least one emulsifier with at least one photoinitiator system and a liquid immiscible with the reactive phase to form an emulsion, provides a scope of the claims to a range that is enabled to one of skill in the art, without undue experimentation.

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Page 7

Dkt: 56139USA5A.002

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-746-4783) to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3688.

Respectfully submitted,

Lian Soon Tan

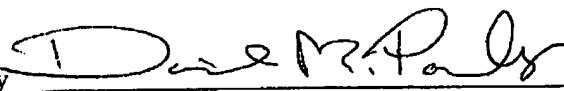
By their Representatives,

Pauly, DeVries Smith & Deffner, L.L.C.
900 IDS Center
Customer Number: 57557
612-746-4783

Date

4/10/2006

By



Daniel M. Pauly
Reg. No. 40,123